

### Remarks

The instant Office Action dated January 26, 2009, notes the following rejections: claims 1, 3 and 7 stand rejected under 35 U.S.C. § 112(1); and claims 1-19 stand rejected under 35 U.S.C. § 103(a) over “AAPA” (Applicant Admitted Prior Art) in view of Arye *et al.* (U.S. Patent No 7,003,794) and further in view of Narasimhan *et al.* (“Network Working Group, Internet Draft, 2002”). Applicant traverses all of the rejections and, unless explicitly stated by the Applicant, does not acquiesce to any objection, rejection or averment made in the Office Action.

Regarding the § 112(1) rejection, Applicant believes that the Examiner’s interpretation of the claims may have overlooked the nature of the claimed “subset” of streams, which involves a number of streams that is fewer than the whole of the set of streams. This is consistent with the specification, as well as the meaning of the term “subset” in and of itself (*i.e.*, a subset is a portion of a set). This is well supported in the specification as well, including the discussion in the Abstract reciting “playing all the streams within the set of streams and muting all the streams within the set of streams, except the subset of streams.” In this regard, the set of streams clearly includes a subset of streams as well as streams that are not in the subset (*i.e.*, at least one stream that is not part of the subset of streams). This discussion in the Abstract is generally compatible with the entire specification, with exemplary embodiments described, for example, at paragraph 29 in connection with FIG. 1, in which the set of streams includes streams S1, S2, S3 and S4, and in which the subset of streams includes stream S1. In this example embodiment, streams S2, S3 and S4 are thus streams that are not in the subset including stream S1. Applicant therefore believes that the § 112(1) rejection is improper and should be removed. Furthermore, a telephone call to the undersigned is welcomed in order to assist the Examiner in understanding the claimed invention as relevant to the above-cited exemplary embodiments.

Applicant submits that the § 103 rejection is improper because the newly-cited reference as disclosed in Applicant’s background (AAPA) expressly teaches away from the claimed invention, which evidences the position that the claimed invention is non-obvious, and further establishes that there is no motivation to combine AAPA as asserted to arrive at the claimed invention. Consistent with the recent Supreme Court decision,

M.P.E.P. § 2143.01 explains the long-standing principle that a § 103 rejection cannot be maintained when the asserted modification undermines either the operation or the purpose of the main (AAPA) reference - the rationale being that the prior art teaches away from such a modification. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007) (“[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious.”). *See also In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984) (A §103 rejection cannot be maintained when the asserted modification undermines purpose of the main reference.).

In this instance, the asserted AAPA as recited in the background of the instant application is directed to multimedia processing in which a server provides a client with a new decoder based upon available bandwidth. This adaptive approach to delivering multimedia is beneficial, for example, “in order to adapt the bit rate of the delivered subset of streams to the available bandwidth of the network.” This facilitates optimization of available bandwidth to achieve goals such as “to minimize data losses on the one hand and maximize the quality of the content received by the client on the other hand” as described at paragraph 0004 of the U.S.P.T.O.’s publication of the instant application. Moreover, the AAPA further achieves its purpose by limiting the number of streams that are transmitted to a subset of streams to be used at a client (*see, e.g.*, paragraph 0005). Limiting the transmission to the subset of streams that will actually be used further achieves the indicated purpose of AAPA, in limiting the use (and congestion) of available bandwidth.

In this context, AAPA clearly teaches away from aspects of the claimed invention as directed to “configuring the client so that the client can decode all the streams within the set of streams,” since AAPA only transmits the subset of streams to be decoded with a particular decoder based upon those streams. The AAPA further teaches away from claim limitations directed to “muting all the streams within the set of streams, except the subset of streams” because only the stream to be used is transmitted. The AAPA similarly teaches away from limitations directed to transmitting a “set of streams including at least one stream that is not part of the subset of streams” because only the subset is transmitted.

As further relevant to the above-discussed teaching away, modifying AAPA to arrive at the claimed invention would render AAPA inoperable for its stated purpose. That is, each of “configuring the client so that the client can decode all the streams within the set of streams,” “muting all the streams within the set of streams, except the subset of streams” and transmitting a “set of streams including at least one stream that is not part of the subset of streams” would eviscerate the need for each of AAPA’s above-discussed functions. For instance, modifying AAPA to configure its client to decode all streams would remove any need to deliver a new decoder to a client decoder or to otherwise optimize the communication of a subset of streams based upon available bandwidth.

Accordingly, the assertion (at page 6 of the Office Action) that the proposed combination of references would be made “with no change in their respective functions” is untenable, as the AAPA clearly must be changed to correspond to the claimed invention as discussed above. This is further consistent with the discussion at page 7 of the Office Action, which clearly states that the proposed combination would allow the “complete removal of Switching of subset of stream on AAPA’s Server side as well as Arye’s client side.” As these and the aforesaid changes are contrary to (and further undermining the purpose of) AAPA, there is no motivation to modify AAPA as asserted.

In addition to the above, the Office Action has not established that the AAPA is capable of communicating all media streams (including streams that are not used) over what appears to be a very limited bandwidth. That is, the Office Action has failed to provide any explanation as to how the proposed modification of the AAPA would result in an operable embodiment. On the contrary, it appears that the communication of all media streams in a set, in addition to those in a subset as claimed, may result in the very congestion problems to which the AAPA is explicitly directed to avoid.

In view of the above, the § 103 rejections are improper because the AAPA teaches away from the claimed invention and any modification thereof to arrive at the claimed invention, because the proposed modification of AAPA would render it inoperable for its purpose, and further because the proposed combination of references does not appear to be operable (*i.e.*, there is no likelihood of success in making the combination). Therefore, all § 103 rejections are improper and should be removed.

Applicant further submits that the § 103 rejection is improper because the cited combination of references fails to teach or suggest all claim limitations. As indicated at pages 3-4 of the Office Action, AAPA fails to disclose multiple limitations including those directed to configuring a client to decode all streams, muting all streams except a subset of streams, and decoding the subset of streams. The Office Action's attempt to add the '794 and Narasimahan references stops short of providing teaching or suggestion of all limitations as required under § 103. As indicated in the Office Action, the '794 reference also fails to disclose muting all streams except a subset of streams, and decoding the subset of streams. This is consistent with the purpose of the '794 reference, in which the cited communication of "bit-rate streams at multiple bit-rates" involves communicating streams at different bit rates (*i.e.*, multiple bit-rates). However, the Office Action has not cited portions of the '794 reference that correspond to decoding all of the bit-rate streams, including the secondary streams as cited. Adding the Narasimahan reference does not appear to cure this deficiency. Accordingly, the Office Action has failed to show teaching or suggestion of all claim limitations, as well as others in the dependent claims. However, in view of the above-established improprieties in the § 103 rejections, further discussion of this lack of correspondence is believed unnecessary at this time.

Applicant has amended claims 2, 5 and 17, which respectively depend from independent claims 1, 3 and 7, which stand rejected under § 112(1). Applicant submits that, while these amendments are believed to be unnecessary to overcome any § 112(1) rejection over the claims from which they depend, the amended claims further render the § 112(1) rejection inapplicable and should further assist the Examiner in understanding the subject matter as claimed. Applicant further believes that these amendments should be entered and the remarks herein considered, as the amendments are germane to addressing the § 112(1) rejections in advance of Appeal.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Aaron Waxler, of NXP Corporation at (408) 474-9068.

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